

## **REMARKS**

Claims 1-10, 12-35, 48-50, and 52 are pending. Claim 1 has been amended. Claim 52 has been added.

### **Double Patenting**

The claims stand rejected under the doctrine of obviousness-type double patenting over Application Serial Nos. 09/465,300 (now U.S. Patent 6,511,648), 09/466,582, 09/599,364 (now U.S. Patent 6,511,649), 09/281,209 (now U.S. Patent 6,524,553), and 09/948,807. Applicants appreciate the Examiner's indication that the rejection need not be rebutted until the withdrawal of all other rejections.

### **Section 112, Second Paragraph**

Claims 1-10, 12-35, and 48-50 stand rejected under 35 USC §112, second paragraph, as being allegedly indefinite. Claim 1 has been amended to add a proviso which overcomes the Examiner's concerns. Claims 2-10, 12-35, and 48-50 depend from and further limit claim 1, and so are allowable as well.

### **Obviousness**

Claims 1, 2, 12-15, 17, 19-23, 25, 27, 28, 31-35, 48, and 49 have been rejected under 35 USC §103 over U.S. Patent No. 5,780,426 ("Palladino"), however, the rejection is believed to be moot in view of the foregoing amendment.

Applicants are concerned that impermissible hindsight is being used to give undue weight to the Palladino reference's single recitation of "chelator," mentioned as an example of

penetration enhancers for peptide absorption in amongst a group which includes "surfactants, nonsurfactants, bile salts, [and] fatty acids." The Office action appears to imply that because chelators are known to enhance peptide absorption, it would be obvious *to link* the peptide and chelator together. This is contrary to the teachings of the Palladino reference, which does not disclose or even suggest that the targeting moiety and chelator are bound. To the contrary, the Palladino reference implies the enhancers are separate components by using the term "co-administration" (col. 16, line 49), as well as by stating:

The penetration enhancers can be used in the solution with the compounds of this invention where the compound and the penetration enhancers are in a pharmaceutically acceptable sterile solution which can be administered, for example by nasal administration. Alternatively the penetration enhancers can be included in a powered formulation that can be administered as a aerosol by suspending the particulate matter in the stream of air and having the patient inhale the suspended particles.

(col. 17, lines 12-20). Thus, Applicants respectfully submit that, among others, the portion of Applicants' claim 1 which recites that "the targeting moiety is bound to the chelator" is not amenable to being rendered *prima facie* obvious by the Palladino reference.

Moreover, the Palladino reference does not disclose or even suggest that there a linking group between the targeting moiety and chelator, let alone the claimed structure of the linking group.

Thus, Applicants submit that no *prima facie* case of obviousness may be made using the Palladino reference by itself.

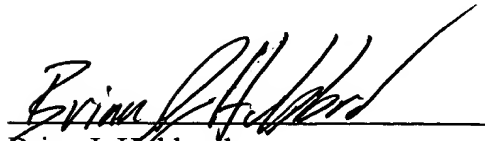
If the Examiner has any questions, the Examiner is invited to call the undersigned

DOCKET NO.: BMS-0650  
Application No.: 09/281,474  
Office Action Dated: September 22, 2003

PATENT  
REPLY FILED UNDER EXPEDITED  
PROCEDURE PURSUANT TO  
37 CFR § 1.116

representative at (215) 568-3100.

Date: *December 22, 2003*

  
\_\_\_\_\_  
Brian J. Hubbard  
Registration No. 45,873

Woodcock Washburn LLP  
One Liberty Place - 46th Floor  
Philadelphia PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439

246143.1